

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/719,321
Inventor(s) : Dennis Osamu Hirotsu
Filed : November 21, 2003
Art Unit : 3761
Examiner : Paula L. Craig
Docket No. : AA551C
Confirmation No. : 3072
Customer No. : 27752
Title : DISPOSABLE ABSORBENT ARTICLES CONTAINED
IN PACKAGE HAVING WINDOW

PETITION UNDER 37 C.F.R. § 1.181(a)

Mail Stop Petition
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

INTRODUCTORY REMARKS

In response to the Examiner's Answer of July 23, 2008, Appellants hereby petition under 37 C.F.R. § 1.181(a) to designate statements set forth in the Examiner's Answer as new ground(s) of rejection. Authorization is hereby given to charge any fees that may be required for this Petition, or credit any refund or overpayment, to Deposit Account Number 16-2480 in the name of The Procter & Gamble Company.

Remarks begin on page 2 of this paper.

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REMARKS

Appellants hereby petition the Commissioner to designate statements set forth in the Examiner's Answer dated July 23, 2008 as new ground(s) of rejection so that Appellants may properly respond to the new ground(s) of rejection in accordance with MPEP § 1207.03(V).

Background

The Final Office Action dated September 7, 2007 contained a rejection of Claims 1-3 and 5-7 under 35 U.S.C. § 103(a) as being unpatentable over Kuske et al. (US 6,318,555) in view of Lash et al. (US 5,897,542) and further in view of Brisebois et al. (US 6,454,095). The Final Office Action further objected to Claim 2 due to lack of antecedent basis and rejected Claims 1-2 on the basis of obviousness-type double patenting. The Final Office Action indicated that Appellants previous amendment necessitated the new grounds of rejection under 35 U.S.C. § 103(a).

Appellants representative interviewed the case with the Examiner on January 3, 2008 in which the Examiner explained the basis on which the previous Office Action was made final. An Interview Summary of this discussion was mailed on January 9, 2008.

Appellants submitted an Amendment After Final Office Action dated January 7, 2008, along with a Notice of Appeal and a Petition for a One-Month Extension of Time. Appellants amended Claim 2 to address the lack of antecedent basis objection and amended Claim 1 to include proper Markush language. Appellants further provided arguments with respect to the rejection under 35 U.S.C. § 103(a).

Appellants representative inquired with the Examiner on March 6, 2008 to find out whether the Amendment After Final Office Action was being entered or not. The Examiner indicated on March 9, 2008 that the amendment would be entered and that an Advisory Action would be forthcoming.

An Advisory Action dated March 17, 2008 indicated that the previous amendment would be entered and included an Interview Summary of the discussions dated March 6th and March 9th. The Advisory Action reiterated the rejection under 35 U.S.C. § 103(a) based upon Kuske et al. in view of Lash et al. and further in view of Brisebois et al.

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Appellants submitted an Appeal Brief dated April 7, 2008 along with a Petition for a One-Month Extension of Time. The sole ground of rejection to be reviewed on appeal is the rejection of Claims 1-3 and 5-7 under 35 U.S.C. § 103(a) as being unpatentable over Kuske et al. in view of Lash et al. and further in view of Brisebois et al.

A Notice of Non-Compliant Appeal Brief was mailed on April 17, 2008 indicating that the Status of Claims section of the Appeal Brief did not identify the canceled claims.

Appellants submitted a Response to Notice of Non-Compliant Appeal Brief dated May 7, 2008, including a new Status of Claims section identifying the canceled claims.

An Examiner's Answer was mailed on July 23, 2008. The Examiner's Answer indicated that the sole ground of rejection to be reviewed on appeal as indicated in the Appeal Brief is correct. The Examiner's Answer further includes a list of Evidence Relied Upon, which includes the Kuske et al., Lash et al., and Brisebois et al. references. However, the list of Evidence Relied Upon further includes three additional new references, Sorkin (US D312,208), Miller (US 5,865,322) and Nelson (US 3,306,437).

Examiner's Answer Contains Statements Constituting New Ground(s) of Rejection

While MPEP § 1207.03 permits a new ground of rejection in an Examiner's Answer in certain rare circumstances, such new ground of rejection must be prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" and the "Grounds of Rejection" sections of the Examiner's Answer. *See* MPEP § 1207.03. In addition, a new ground of rejection must be approved by a Technology Center Director or designee.

Specifically, MPEP § 1207.03 recites:

A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). **>Where< a newly cited reference is added merely as evidence of the prior ** statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *>41.39(a)(2)<. See also MPEP § 2144.03.

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See MPEP § 1207.03(III) (Rev. 3, August 2005).

In the present appeal, as noted above, the Examiner's Answer includes three additional new references, Sorkin, Miller and Nelson which had not previously been relied upon by the Examiner. With respect to these references, the Examiner's Answer states:

Although not necessary for the above arguments, note that the packaging of different article types together and the placing of colors and other indication means on

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article wrappers are well known in the packaging art. U.S. Design Patent No. 312,208 to Sorkin teaches absorbent articles of six different colors packaged together in a package with a transparent top wall through which all the articles are visible (Description and Figs. 1-2 and 4-5; colors are indicated by different shading in Figs. 2, 4, and 5). U.S. Patent No. 5,865,322 to Miller teaches a device which holds a variety of absorbent articles of various types and absorbencies, including sanitary napkins, each of which may be individually wrapped; the Miller device has window openings through which the articles are visible (Abstract, Figure, col. 2, line 53 to col. 4, line 34, Claims 1 and 7). U.S. Patent No. 3,306,437 to Nelson teaches a receptacle having a window opening, and color coding of wrappers holding different article types within the receptacle and visible to be selected through the opening (Figs. 1-5, col. 1, line 58 to col. 2, line 36, col. 3, line 41 to col. 4, line 63).

See Examiner's Answer at pages 10-11.

Appellants submit that these statements do not merely support prior statements made by the Examiner as to what is "well-known" in the art, but rather imply new ground(s) of rejection for which Appellants have not considered or responded to. Appellants cannot determine from these statements whether the Examiner alleges that the recited reference(s) anticipate or render obvious the present claims, or neither. Therefore, Appellants respectfully request that these statements be found to constitute new ground(s) of rejection and require that new rejection(s) be properly set forth based upon the new references, so that Appellants can properly respond in accordance with MPEP § 1207.03(V).

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Conclusion

In view of the foregoing, designation of the above statements as new ground(s) of rejection is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

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Date: September 23, 2008
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